Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PREETI LAL, KARL J. GUEGLER, and NEIL C. CORLEY

Appeal No. 2002-1561
Application No. 09/397,558

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

The following matter must be addressed before we reach the merits of the issues on appeal.

1. The Furness declaration

It is unclear from the record whether the examiner has entered the declaration under 37 CFR § 1.132 by Lars Michael Furness. The oversight appears to have resulted from the unusual post-appeal prosecution in this application.

The examiner issued a final rejection of the claims in Paper No. 13 (mailed Feb. 9, 2001). Appellants filed a timely Notice of Appeal and Appeal Brief (Paper Nos. 15 and 21, filed May 15, 2001 and August 17, 2001, respectively). The examiner responded with an Examiner's Answer (Paper No. 23, mailed Dec. 7, 2001), and Appellants filed a Reply Brief accompanied by the unexecuted Furness declaration (Paper Nos. 24 and 26, both filed Feb. 15, 2002), followed shortly by the executed declaration (Paper No. 27, filed March 11, 2002).

It is at this point that the record gets confusing. The next paper entered in the record is an examiner's Interview Summary, stating that the Examiner's Answer used an incorrect form paragraph (referring to written description rather than enablement), and that Appellants' representative agreed to issuance of a new Examiner's Answer. See Paper No. 28, dated May 3, 2002. That new Examiner's Answer was issued (also as Paper No. 28) on May 7, 2002. The new Examiner's Answer was styled as a "Supplementary Examiner's Answer" but expressly stated that the previous Examiner's Answer was vacated and replaced by the new one (thus, the new Examiner's Answer did not actually "supplement" the old one). The new Examiner's Answer also stated that it was issued "in response to appellant's [sic] brief on appeal filed August 17, 2001," that is was issued "due to a typographical error by the Examiner," and that "[n]o new issues have been raised." Page 1. The new Examiner's Answer does not refer to either the Reply Brief or the Furness declaration.

Appellants responded by re-filing the Reply Brief and the Furness declaration. See Paper Nos. 30 and 31, both filed June 6, 2002. The next paper in the record is an administrative remand from this board, stating that

> [a] Reply Brief (Paper No. 30) and a Declaration in the name of Lars Michael Furness (Paper No. 31) w[ere] filed on June 6, 2002. The examiner has not seen these papers. The Reply Brief needs to be considered by the examiner with respect to compliance with the criteria set forth in 37 CFR § 1.193(b)(1).

Paper No. 32, mailed July 8, 2002.

The examiner responded that

> [t]he Board of Appeals remanded the case to the Examiner in view of Appellants[']declaration submitted June 6, 2002 as Paper number 31 subsequent to the Supplementary Examiner's Answer, Paper number 28, mailed May 7, 2002. The said declaration is identical to the declarations submitted as Papers 26 and 27 received February 15, 200[2] and March 11, 2002, respectively. These declarations were considered in the Supplementary Examiner's Answer, Paper number 28, mailed May 7, 2002. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Paper No. 33, mailed Dec. 4, 2002 (emphasis added).

We have reviewed the "Supplementary Examiner's Answer" (Paper No. 28) but have been unable to find any reference therein to either the Reply Brief or the Furness declaration. Thus, it is unclear whether the record on appeal includes the Furness declaration. "In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument. . . . [T]he ultimate determination of patentability is made on the entire record." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Since we must consider all the evidence in the record in reviewing the examiner's

rejections, the examiner must make clear whether evidence, such as the Furness declaration, is properly a part of the record on appeal.

On return of this application, the examiner should clarify whether or not the Furness declaration filed June 6, 2002 (Paper No. 31), has been entered. Evidence, such as a Rule 132 declaration, is not entered a matter of right after a notice of appeal has been filed. See 37 CFR § 1.195 ("Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented."). See also Manual of Patent Examining Procedure (MPEP) § 1211.02 ("If such an affidavit or declaration is not accompanied by the showing required by 37 CFR 1.195, the examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the examiner will admit the same and consider its merits.").

The examiner should state on the record whether the declaration has been entered. If the examiner refuses to enter the proposed declaration, and Appellants seek review of that decision, review must be sought by way of petition, not appeal. See 37 CFR § 1.127.

2. Future proceedings in this application

If the examiner decides that the Furness declaration is entitled to entry, we authorize the examiner to enter a Supplemental Examiner's Answer responding to the declaration. See MPEP § 716.01: "All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. . . . Where the evidence is

insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient."

If the examiner files a Supplemental Examiner's Answer, Appellants are entitled to file a Supplemental Reply Brief.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

SHERMAN D. WINTERS)
Administrative Patent Judge)
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) BOARD OF PATENT
WILLIAM F. SMITH)
Administrative Patent Judge) APPEALS AND
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